

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

**Rejections Under 35 USC 102(b)**

Applicants traverse the rejection of claim 4 under 35 USC 102(b) as being anticipated by US Patent No. 5,747,049 (“the ‘049 patent”, referred to as Tominaga in the outstanding office action). Nothing in the ‘049 patent suggests that either ginseng extract or Coicis semen extract have an anti-aging effect. The ‘049 patent is totally silent with respect to the effect exhibited by the addition of plant extracts. Moreover, the ‘049 patent requires the presence of aminoethylsulfyl compounds of formula (I). See column 2, lines 10-14. Aminoethylsulfyl compounds, however, are not required by the present invention. Therefore the ‘049 patent cannot anticipate the present invention.

Applicants wish to point out that the ‘049 patent merely states “it is also possible to add various plant extracts into the preparation for various purposes.” See column 6, lines 59-60. None of these plant extracts were added to any of the working examples of the ‘049 patent. Therefore, because plant extracts were disclosed as merely possible additions to the preparation of the ‘049 patent, this reference cannot anticipate the present invention. As stated in MPEP § 2112, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.’ ” *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)

**Conclusion**

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By



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